

## REMARKS/ARGUMENTS

Prior to this Response, a Final Office Action was mailed March 25, 2010.

In the Final Office Action, the Examiner rejected claims 29-33 and 39-59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 7,272,788 to Anderson et al. (hereinafter Anderson) in view of U.S. Pat. No 6,801,962 to Taniguchi et al. (hereinafter Taniguchi) and in further view of U.S. Pat. App. Pub. 2002/0038612 to Iwazaki.

In this Response, Applicant reasserts previously submitted arguments, namely that Anderson and Taniguchi are not prior art, and that even if so, all currently pending claims are patentable as Anderson and Taniguchi, either alone or in combination, fail to describe or disclose each and every element recited in the claims.

Claims 29-33 and 39-59 are pending in the present application. Claims 29, 31, 50, and 59 are in independent form. Applicant requests reconsideration and allowance of all pending claims. The Applicant makes the following remarks regarding individual issues:

### THE APPLICANT'S TIME TO RESPOND

The last Office Action was mailed on March 25, 2010. The three-month initial deadline to respond without having to pay a penalty fee ends on June 25, 2010 and Applicant files this Response before that deadline.

### INTERVIEW SUMMARY

On May 26, 2010, Applicant William Chang, Applicant's representative Jon Reali, and Examiner Marcus T. Riley participated in a telephone conference regarding the Final Office Action mailed March 25, 2010. During the telephone conference the parties primarily discussed the Anderson and Taniguchi patents. In particular, Applicant asserted that the Anderson and Taniguchi patents were not prior art to the currently pending claims. Specifically, Applicant asserted that

all currently pending claims would benefit from the January 19, 2001 filing date of U.S. Provisional Application No. 60/262,764 to which the instant application claims priority and that the January 19, 2001 filing date predated both the Anderson and Taniguchi filing dates (February 27, 2001 and July 25, 2001 respectively). To support their argument, Applicant referred to the "Priority Table" included in their December 22, 2009 Response (and included in this Response below for convenience) that maps each currently pending claim element to a specific portion of the 60/262,764 provisional application for support. The Applicant did not propose any claim amendments during the conference.

In response to the Applicant's position, and as indicated by the Examiner's Interview Summary mailed June 3, 2010, the Examiner understood the Applicant's position but respectfully disagreed. The Examiner indicated, however, that he would formally consider the Applicant's proposed position (i.e., that Anderson and Taniguchi are not prior art) by taking a more in depth look at the prior art following the Applicant's submission of this Response to the March 25, 2010 Final Office Action.

**SUPPORT FOR CLAIMS FROM PROVISIONAL APPLICATION 60/262,764**

Applicant asserts that each claim element in the currently pending claims is supported by the provisional application 60/262,764 filed on January 19, 2001. The Priority Table included below maps each claim element to the provisional application 60/262,764. Accordingly, Applicant asserts that each currently pending claim should receive the benefit of the January 19, 2001 filing date.

<b>Priority Table</b>	
<b>Claim Element</b>	<b>Examples of Support in 60/262,764</b>
Information apparatus	(Page 1, line 17-22), (Page 11, line 33-35), (Page 12, line 1-2), Fig 1 (100)
Mobile wireless information apparatus	(Page 1, line 17-22), (Page 11, line 33-35), (Page 4, line 11-13), (Page 12, line 21-24), (Page 39, line

	1-2)
Content	(Page 14, line 31-32 ), (Page 3, line 17-18), (Page 2, line 3-4), Fig 4 (400), Fig 7 A (700), Fig 7B (700)
Output content	(Page 2, line 3-4), (Page 3, line 4-5), (Page 4, line 15-18 ), (Page 7, line 10-13), (Page 3, line 17-18)
Interface for interacting with a user	(Page 12, line 5-10), (Page 14, line 16-17), (Page 28, line 15-16), Fig 5 (500), Fig 6 (600), Fig 7A (720), Fig 7B (720)
Obtain user preference	(Page 14, line 18-20), (Page 29, line 5-7), (Page 33, line 1-2), (Page 29, line 3-4), (Page 35, line 15-17)
Touch sensitive screen	(Page 12, line 5-10)
Processing unit	(Page 12, line 4-6), (Page 13, line 9-11)
Memory unit	(Page 12, line 4-6)
Software	(Page 10, line 6), (Page 13, line 6-7), (Page 13, line 9-17)
Client application/Application software	(Page 2, line 16-17), (Page 4, line 15-18), (Page 13, line 6-7), (Page 13, line 9-11), (Page 31, line 1-4), Fig 1 (110), Fig 5 (530), Fig 6 (612)
User invoke client application	(Page 28, line 5-6), (Page 31, line 9-10)
Wireless communication unit	(Page 21, line 5-9), (Page 22, line 25-27), Fig 2A, 2B
Short range wireless communication	(Page 12, line 22-23), Fig 2A, 2B
Radio Frequency	(Page 12, line 21-24), (Page 12, line 24-25), (Page 21, line 5-9), (Page 21, line 21-24), Fig 1 (140), Fig 2A
Output device	(Page 1, line 22-24), (Page 1, line 27-30), (Page 14, line 25-26), (Page 30, line 6-9), Fig 1 (120)

Output controller	(Page 16, line 19-24), Fig 1 (130), Fig 3 (3C, 130C)
Wireless output device	(Page 20, line 18-19), Fig 1 (120, 140), Fig 3 (3A, 3B, 3C)
Printer	(Page 14, line 26-27), (Page 1, line 22-24)
Display or projection device	(Page 1, line 22-24), (Page 30, line 6-9), (Page 14, 28-29)
Audio device	(Page 1, line 22-24), (Page 14, line 30-32), (Page 30, line 6-9)
Downloading digital data content	(Page 24, line 8-10), (page 24, line 18-20), (page 33, line 14-17), (page 33, line 20-24), (page 33, line 27-29)
Obtain content	(Page 13, line 20-24), (Page 14, line 8-12), (Page 24, line 8-10), (Page 24, line 18-20), (Page 28, line 10-13), (Page 32, line 25), (Page 33, line 12-13),(Page 33, line 20-24), (Page 33, line 27-29)
Selecting digital content	(Page 13, 20-24), (Page 27, line 32),
Opening wireless communication	(Page 27, 32), (Page 13, 20-24), Fig 2A, 2B
Searching over wireless	(Page 31, 19-23), (Page 31, 16-17), (Page 28, 20-22), Fig 6 (601)
Discovering over wireless	(Page 19, 10-12), (Page 28, 19-23), (Page 30, 19-24), Fig 5 (520), Fig 6 (602)
Discovering via a control point	(Page 31, line 19-24)
Device dependent attribute	(Page 32, line 26), (Page 32, line 5-10)
Device independent attribute	(Page 42, line 32-34), (Page 35, line 11-13), (Page 32, line 32-33)
Receiving/obtaining device dependent attribute	(Page 8, line 34, Page 9, line 1-2), (Page 9, line 11-16), (Page 30, line 19-20), (Page 32, line 5-10), (Page 32, line 26), (Page 33, line 31-33), (Page 34,

	line 4-6), (Page 39, line 11-15), (Page 42, line 32-34)
Receive profile	(Page 9, line 4-6), (Page 19, line 8-9), (Page 29, line 1-5), (Page 32, line 26), (Page 34, line 4-6)
Selecting a wireless output device	(Page 28, line 18), (Page 34, line 28-29), (Page 30, line 21-24), (Page 31, line 12), (Page 28, line 19-23), Fig 5 (510), Fig 6 (608)
Selecting base on attribute	(Page 30, line 21-24), (Page 34, line 28-29), (Page 34, line 30-31)
Establishing a wireless connection	(Page 26, line 12-14), (Page 30, line 26-27), (Page 32, line 17-18)
Establish a temporary network	(Page 8, lines 8-11)
Not including an external print server	(Page 8, lines 8-11), (Page 23, 1-3), (Page 17, 13-19), Fig 3 (3A, 3B)
Direct data output	(Page 3, line 17-19), Fig 3 (3A, 3B)
Output data/Print data/metafile	(Page 2, line 4-5), (Page 2, line 9-10), (Page 14, line 33-35, Page 15, line 1), (Page 39, line 18-20)
Output data includes a format, language, protocol	(Page 26, line 3-4), (Page 2, Line 9-10)
Conforming/generating output data	(Page 13, line 24-31), (Page 13, line 32-35), (Page 27, 33-34), (Page 29, line 1-5), (page 33, line 4-6), (Page 33, line 7-8), (Page 38, line 3-4), Fig 4 (410), Fig 4 (420), Fig 7A (730), Fig 7A (740), Fig 7B (725), Fig 7B (740)
Conforming based on attribute/profile	(Page 25, line 6-7), (Page 29, line 6-7), Fig 7A (730), Fig 7B (725)
Compression	(Page 9, line 20-23), (Page 13, line 32 - 34), (Page 26, line 3-4), (Page 36, line 15-19), (page 43, 14-15)

Rasterize	(Page 13, line 24-31), (Page 25, line 6-7), (Page 36, line 4-10), Fig 7A (730), Fig 7B (725)
Device independent	(Page 25, line 17-21), (Page 37, line 12-14), (Page 38, line 1-2), (Page 38, line 9-15)
Output data includes at least an image	(Page 27, line 33-35), (Page 43, line 6-8), (Page 42, line 19-20)
One or more image layer	(page 26, line 30-35), (Page 27, line 1-2), (Page 39, line 29-33), (Page 40, line 25-26), (Page 43, line 20-21)
Each image layer including distinct resolution	(Page 26, line 30-35, Page 27, line 1-2), (Page 39, line 29-33), (Page 43, line 20-21)
Transferring/transmitting output data over wireless	(Page 8, line 2-3), (Page 13, line 3-4), (Page 26, line 12-13), (Page 28, line 1), (Page 29, 8-10), (Page 33, 7-8), (Page 36, 26-29), Fig 4 (430), Fig 7A (750), Fig 7B (750)
Authentication	(Page 9, line 24), (Page 36, line 33-34), (Page 37, line 1-2)
Sending security key for authentication	(Page 19, line 17-20), (Page 20, line 33-34), (Page 21, line 1-2), (Page 37, line 1-2)
In dependence of a successful authentication	(Page 19, line 17-21), (Page 20, line 33-34), (Page 21, line 1-2)
Establish restricted wireless connection	(Page 19, 20-21), (Page 36, line 33-34)
Billing/payment	(Page 9, line 23), (Page 19, line 12-13), (Page 37, line 2-6)
Bluetooth & IEEE802.11	(Page 12, line 21-24), (Page 21, line 21-24)

#### THE SECTION 103(A) OBVIOUSNESS REJECTION

The Examiner rejected claims 29-33 and 39-59 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Taniguchi and in further view of

Iwazaki. For at least the following reasons, the Applicant traverses the Examiner's rejection.

#### **A. Anderson**

As a preliminary matter, the present application was filed January 18, 2002 and claims the benefit of U.S. Provisional Application No. 60/262,764, filed on Jan. 19, 2001. Support for each claim element can be found in Application No. 60/262,764 as shown in the Priority Table included above. Anderson has an earliest effective filing date on February 27, 2001, which is after the effective filing date of present application. Accordingly, Anderson is NOT prior art to the present application.

Applicant therefore asserts that the Examiner's § 103 rejection is improper. It would not have been obvious at the time the invention was made to a person of ordinary skill in the art to combine Anderson with anything because at least the cited portions of Anderson would have not been available. Applicant respectfully requests that the Examiner withdraw his § 103 rejection of any claim for which he relies on Anderson's disclosure either alone or in combination with Taniguchi and/or Iwazaki.

#### **B. Taniguchi**

Taniguchi was filed in the U.S. on July 25, 2001 with claims to foreign (Japan) applications having filing dates of July 26, 2000 and August 29, 2000 respectively. Applicant asserts that under 35 U.S.C. § 102(e), the effective filing date of Taniguchi as a reference against the present application is the U.S. filing date of July 25, 2001, which is after the effective filing date of the present application. Specifically, it is not clear if either Japan application was a Patent Cooperation Treaty application designating the United States. Further, Applicant does not believe that either Japan patent application was published in English. Further still, it is unclear whether or not the portions of Taniguchi cited against the present application would be supported by the earlier applications. Accordingly, Taniguchi is NOT prior art to the present application.

Accordingly, Applicant asserts that the Examiner's rejection under § 103 is improper. It would NOT have been obvious at the time of the invention was made to a person of ordinary skill in the art to combine Taniguchi (namely, the cited paragraphs by the Examiner) with anything because at least those cited portions of Taniguchi would have not been available at the time of the invention. Applicant respectfully requests that the Examiner withdraw his § 103 rejection of any claim for which he relies on Taniguchi's disclosure either alone or in combination with Anderson and/or Iwazaki.

### **C. Obviousness**

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the § 103 rejection as neither Anderson nor Taniguchi is prior art. Even if prior art, Applicant asserts that all previously presented claims are patentable over Anderson in view of Taniguchi and in further view of Iwazaki.

Even if the Examiner can demonstrate that Anderson and/or Taniguchi is prior art, Applicant respectfully asserts that they have overcome the Examiner's obviousness rejection as Anderson, Taniguchi, and Iwazaki, either individually or in combination, fail to describe or disclose each and every element recited in the claims.

The standard under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In re O'Farrell, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." KSR Int'l v. Teleflex, Inc., 127 S.Ct. 1727, 1742, 167 L.Ed.2d 705 (2007). The Examiner bears the initial burden in the case of Section 103(a) obviousness rejection which requires the Examiner to put forward evidence that the invention as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984), citing In re Warner, 379 F.2d 1011, 1016 (CCPA 1967). Moreover, the Examiner cannot rely on the applicant's disclosure in any way in making this prima facie



case. MPEP 2143. The foundational facts for the prima facie case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art. Graham v. John Deere Co., 383 U.S. at 17-18; Miles Lab., Inc. v. Shandon Inc., 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 231, 236 (Fed. Cir. 1983). Each obviousness determination rests on its own facts. In re Durden, 226 USPQ 359, 361 (Fed. Cir. 1985). Where the Examiner relies on a single prior art reference for an obviousness rejection, which does not describe every limitation of the claim, the Examiner must demonstrate how a person of ordinary skill in the art would have been motivated to modify the reference to achieve the invention without the benefit of hindsight, just as with a combination of references.

Applicant hereinafter provides specific remarks for various elements recited by the currently pending claims.

#### **1. Wireless Communication Unit**

Claim 29 recites ". . . the information apparatus including a wireless communication unit for short range wireless communication with one or more output devices. . . ." Support for the element can be found at least in figure Fig. 2A, Fig 2B, and Paragraphs [0081], [0082], [0131], and [0079]. For example:

*[Parag 0081] In one embodiment of the present invention, communication interface 240 between information apparatus 200 and output device 220 or output system 250 is a wireless communication interface such as a short-range radio interface...*

*[Parag 0082] For simplicity, Fig. 3 illustrates one implementation where an information apparatus 200 includes one communication unit 350...*

Independent claims 31, 50 and 59 recite at least a similar “wireless communication unit.”

## **2. Interface for Interacting with a user**

Claim 29 recites the information apparatus including “. . . an interface for interacting with a user. . . .” Support for the above element can be found at least in Paragraph [0078]. For example:

*[Parag 0078] . . . Information apparatus 200 may include an interface (not shown) for interaction with users. The interface may be implemented with software or hardware or a combination. Examples of such interfaces include, without limitation, one or more of a mouse, a keyboard, a touch-sensitive or non-touch-sensitive screen, push buttons, soft keys, a stylus, a speaker, a microphone, etc . . .*

Independent claims 31 and 59 recite at least a similar “interface for interacting with a user.”

Moreover, independent claim 31 further recites “. . . the interface including at least a touch sensitive screen. . . .” Neither Anderson nor Taniguchi, either alone or in combination, describe or suggest an interface for interacting with a user, the interface including at least a touch sensitive screen.

## **3. A Selected Content for Output**

Claim 31 further recites “. . . receiving over the interface from the user at least an indication related to a selected content for output. . . .” Support can be found in at least Paragraphs [0086] and [0151]. For example:

*Paragraph [0086] . . . the client application 210 may provide its own capability for user to browse, edit and or select a digital document . . .*

*Paragraph [0151] A user interface component and operation where a user initiates an output process and provides an indication of the selected output content (e.g. digital document) for output.*

#### 4. Other Than Printing Device

Anderson discloses a method of merging metadata with digital images by uploading from a client an image to an online website over the Internet. The online site stores the uploaded image at a server; subsequently, the online site (server) provides a web application to the client enabling the user to input selection parameters which is then used by the online site to populate the metafile fields associated with the image stored online at the server.

Anderson is not related to the field of transferring digital data content from an information apparatus to a wireless output device by short range wireless communication as recited by claim 29.

Examiner alleges that Anderson discloses that “. . . the term image also encompasses media types such as movies, sound annotations.” Applicant asserts however that media type is not a device, nor is media type an output device, nor is media type a wireless output device. Anderson is silent regarding an output device. Taniguchi, on the other hand, is directed solely to printing devices. Neither Anderson nor Taniguchi teaches a “. . . wireless output device being at least one of an audio device, a projection device, and a display device, other than a printing device . . .” as recited by independent claim 29.

More specifically, Applicant submits that the Examiner's rejection fails to identify any teaching in the references regarding the feature recited in the claim. Applicant asserts that Taniguchi is directed solely to a printer output system, and that Anderson is directed to merging metafiles at an online site. There is neither teaching nor suggestion to modify an Internet online site taught by Anderson to a printer data output system of Taniguchi to formulate a selected wireless output device that is “at least one of an audio device, a projection device and a display device other than a printing device.” The recited element is neither described nor suggested by Anderson or Taniguchi, taken either independently or in combination. Moreover, Applicant asserts that a person of ordinary skill in the art would not look to the printer output system of Taniguchi as a means of modifying a system for output devices other than for printers.

Further, claim 29 further recites “. . . the selected wireless output device being at least one of an audio device, a projection device, and a display device other than a printing device . . . .” Neither Anderson nor Taniguchi describe or suggest selecting an audio device, a projection device or a display device. Taniguchi describes selecting a printing device after searching a database for printer information. In contrast, claim 29 recites “selecting . . . . other than a printing device. . . .” Consequently, neither Anderson nor Taniguchi teaches or suggest that “the selected wireless output device being . . . . other than a printing device . . . .” as recited by independent claim 29.

## **5. Downloading Content**

Claim 29 recites “. . . downloading at the information apparatus the digital data content from a server over a network to the information apparatus. . . .” Examiner alleges that Taniguchi does not disclose this feature. Applicant agrees. However, Examiner alleges that Anderson column 2 lines 15-18 teach the same. Applicant respectfully disagrees. Anderson column 2 lines 15-18 recite:

*. . . the method and system includes receiving data uploaded from a remote location to a web server, providing a web application to a client application. . . .*

Applicant, however, notes that Anderson column 3 lines 44-46 recite the following:

*Once connected to the Internet, the client device 112 having the capability of uploading the digital images to the online photo service site 14. . . .*

Applicant asserts that Anderson merely describes uploading images from a client device 112 to a web server at an online photo service site. This is contrary to “. . . downloading at the information apparatus the digital data content from a server over a network to the information apparatus. . . .” as recited by independent claim 29. Accordingly, Applicant asserts that neither Anderson nor Taniguchi disclose or suggest downloading at the information apparatus the

digital data content from a server over a network to the information apparatus as recited by claim 29.

Independent claims 31 and 59 recite at least a similar element, namely the content being downloadable or accessible from a server over a network to the mobile information apparatus. Applicant therefore asserts that independent claims 29, 31, and 59 are patentable as each recites at least an element not taught by Anderson or Taniguchi, either alone or in combination.

## 6. Searching

In addition to the patentable distinctions discussed above, claim 29 further recites “. . . searching wirelessly over the wireless communication channel for one or more wireless output devices available for wireless connection. . . .”

Examiner alleges that Taniguchi’s “output device search means” at the portable terminal #73 (e.g., as illustrated by Taniguchi Figs. 8 and 15, column 12 line 57, and column 16 lines 24-37) teaches searching means. Applicant disagrees. Applicant asserts that the searching means described by Taniguchi is merely searching a database stored in the memory of a device (e.g. portable terminal #73). For example, the passages describing “output device search means” of Taniguchi are reproduced below:

*The portable terminal device 73 searches for the output device 74 based on the received image data creation information and the output device information stored within the portable terminal device 73 (S82).*

*Taniguchi, column 14 lines 1-4*

*Next, a method for selecting an output device by a portable terminal will be explained. The output device is searched for based on information on the output device and the image data creation information, thereby selecting one of a plurality of output devices detected as a result of the search. Here, the portable terminal device obtains output device information necessary for the search*

*from a database, thereby detecting the output device based on the image data creation information.*

*Taniguchi, column 21 line 64 bridging column 22 line 4*

Taniguchi emphasizes the benefit of searching a database by "updating the data of the database with the information of output devices provided lately, it is possible to obtain the latest output device information, thereby allowing the user to use such new output devices." The entire passage is shown below:

*Further, in the selection of an output device, output device information can be obtained from an external database, thereby the information no longer requires to be held, thus requiring no large capacity of a memory or the like. Further, by updating the data of the database with the information of output devices provided lately, it is possible to obtain the latest output device information, thereby allowing the user to use such new output devices. Moreover, the user can learn the current status of an output device, thereby enabling the user to select an output device by avoiding those occupied or out of order. This greatly saves the user's time which is conventionally wasted so as to await output and/or repeat searches.*

*Taniguchi, column 22 lines 37-44*

Applicant therefore asserts that Taniguchi does not teach or suggest anything akin to "searching wirelessly over the wireless communication channel for one or more wireless output devices available for wireless connection" as recited by independent claim 29. Instead, Taniguchi merely teaches one skilled in the art to search a database stored in the memory of a device such as portable terminal #73 for output device information.

Applicant further asserts that Taniguchi Figs. 15 and 18 do not teach or suggest that searching over the wireless link #81 equates to searching for wireless devices available for wireless connection as recited in claim 29.

Taniguchi column 16 lines 25-34 (describing Figs. 15 and 18) describe link #81 as follows:

*Next, a second data output method will be explained. As shown in FIG. 15, when the output device 74 is not directly connected with the server 72 via the communications line, and when an output request is sent from the portable terminal device 73 to the server 72, the server 72 sends image data to the portable terminal device 73. The portable terminal device 73 is then connected with the output device 74 via a wireless communications line 81, and a mode to send the image data to the output device 74 that was selected when the image data was received becomes available.*

Accordingly, Applicant asserts that Taniguchi does not teach or suggest searching over the wireless communication channel for wireless devices available for wireless connection. Instead, Taniguchi teaches that the portable terminal device 73 is connected with the output device 74 via a wireless line 81 for sending the image data to the output device when the output device 74 is not directly connected with the server 72.

Applicant further asserts that searching wirelessly over the wireless communication channel for one or more wireless output devices available for wireless connection is not related to the art of searching a database as described in Taniguchi. Accordingly, Taniguchi cannot teach one skill in the art the element of "searching wirelessly over the wireless communication channel" as recited in claim 29,

Independent claims 50 and 59 recite at least a similar element, namely searching wirelessly over the wireless communication channel for a wireless output devices available for wireless connection. Applicant therefore asserts that independent claims 29, 50, and 59 are patentable as each recites at least an element not taught by Anderson or Taniguchi, either alone or in combination.

## **7. Receiving Device Dependent Attribute**

In addition to the many patentable distinctions outlined above over the cited references, claim 29 further recites ". . . receiving at the information apparatus over the wireless communication channel a device dependent attribute that corresponds to each wireless output device found in the wireless search. . . ."

Taniguchi does not describe nor suggest anything akin to "receiving at the information apparatus over the wireless communication channel a device dependent attribute that corresponds to each wireless output device found in the wireless search." Instead, Taniguchi describes retrieving output device information from a database stored in memory of the portable terminal.

Moreover, Taniguchi does not describe nor teach that the received device dependent attribute over wireless communication channel includes at least one of a name, a device identity, a device type, a device address, and a device profile corresponding to each wireless device. For example, Taniguchi column 15 lines 25-44 recite:

*Meanwhile, in the portable terminal device 73, when a condition on which the output device 74 is searched for is set, necessary output device information is stored in such storage means as the RAM, an EEPROM (Electrically Erasable Programmable ROM) and a flash memory of the portable terminal device 73. The output device information includes: the location of the output device 74, the performance of the output device 74 (color print or black and white print, double-sided print or single-sided print, the presence or absence of a zoom in/out print mode, the presence or absence of a stapler mode, the presence or absence of a sorting mode, and the presence or absence of such modes as paper size selection, paper type selection, print rate selection, resolution selection, print density level section, two-in-one, and four-in-one modes), the current status of the output device 74 (currently occupied or not, the number of standby jobs, a remaining quantity of toner, occurrence or non-*



*occurrence of paper jam, a remaining quantity of paper in a paper tray, occurrence or non-occurrence of erroneous service, etc.)*

However, Applicant asserts that Taniguchi does not describe output device information including a name, a device identity, a device type, a device address, and a device profile as recited in claim. Additionally, independent of whether Taniguchi describes that the device dependent attributes including at least one of a name, a device identity, a device type, a device address, and a device profile, Taniguchi teaches to “read out” the output device information from memory and not by receiving or obtaining output device information over the wireless communication channel as recited by independent claim 29.

Independent claims 31, 50, and 59 recite at least a similar element, namely receiving or obtaining over the wireless communication channel an attribute that corresponds to the wireless output device found in the wireless search. Applicant therefore asserts that independent claims 29, 31, 50, and 59 are patentable as each recites at least an element not taught by Anderson or Taniguchi, either alone or in combination.

## **8. Selecting**

In addition to the many patentable distinctions discussed above, claim 29 further recites “. . . selecting at the information apparatus a wireless output device discovered in the search based at least in part on the received device dependent attributes received over the wireless communication channel from each of the wireless output devices. . . .” The amendment clarifies that the selection is based at least in part on the received device dependent attributes received over the wireless communication channel from each of the wireless output devices.

As previously noted, Taniguchi column 15 lines 25-30 and column 21 line 64 bridging column 22 line 4 merely teach selecting an output device based on searching a database, for example, stored in the memory of the portable terminal device. For example:

*. . . necessary output device information is stored in such storage means as the RAM, an EEPROM (Electrically Erasable Programmable ROM) and a flash memory of the portable terminal device 73*

*The output device is searched for based on information on the output device and the image data creation information, thereby selecting one of a plurality of output devices detected as a result of the search. Here, the portable terminal device obtains output device information necessary for the search from a database, thereby detecting the output device based on the image data creation information.*

Accordingly Taniguchi does not teach or suggest "selecting based . . . on the device dependent attributes received over the wireless communication channel from each of the wireless output devices" as recited by independent claim 29. Instead, Taniguchi teaches selecting "one of a plurality of output devices detected as a result of the search in the memory of the portable terminal" or from a database.

Independent claims 31, 50, and 59 recite at least a similar element, namely selecting an output device based on the device dependent attributes received over the wireless communication channel. Applicant therefore asserts that independent claims 29, 31, 50, and 59 are patentable as each recites at least an element not taught by Anderson or Taniguchi, either alone or in combination.

## **9. Conforming**

With regard to the feature "conforming at the information apparatus at least part of the digital data content into an output data" recited in claim 29, the Examiner alleges that Taniguchi column 12 lines 13-28 and column 12 line 57 to column 13 line 3 teach the same. Applicant respectfully disagrees. For example, the cited portions of Taniguchi recite:

FIG. 8 shows a data output system according to the present embodiment. This system includes a client 71 who creates image data, a server 72, a portable terminal device 73, and a plurality of output devices 74 provided on different sites, all of which are connected via a network. The network utilized here is a wide area network (WAN) selected from the group consisting of such local area networks (LAN) as the Ethernet and optical communications, such public networks as a public communications line and a wireless communications line, and such private line networks as a high-speed digital line and the like. Either one of these networks is connected, as a communication medium, with the client 71, the server 72, the output devices 74 and the portable terminal device 73 so that they are mutually accessible, thereby performing internal data communication in accordance with a predetermined communication protocol.

*Taniguchi, column 12 lines 13-28*

Further, the client 71 has a mode to send the created image data to the server 72 and a mode to send an identification code (terminal ID) of the portable terminal device 73 that is carried by the user 79 who intends to notify the server 72 of information on the creation of the image data ("image data creation information", hereinafter). The portable terminal device 73 has a mode to search for the output device 74 to be used to output image data when receiving the image data creation information according to a predetermined criteria, a mode to select one output device 74 out of a plurality of the output devices 74 detected by the search, a mode to send a request for outputting the image data to the server 72, and a mode to send an identification code (output ID) of the selected output device 74 to the server 72.

*Taniguchi column 12 line 57 bridging column 13 line 3*

The cited paragraphs included above do not teach one skilled in the art anything related to “conforming at the information apparatus at least part of the digital data content into an output data” as recited by independent claim 29. The passage at lines 13-28 merely recites the hardware elements used in the Taniguchi system. The other passage refers to image data and other data being sent to a server. Neither these passages, nor any other part of the cited references teaches or suggests “conforming at the information apparatus at least part of the digital data content into an output data.”

Moreover, claim 29 further recites “. . . the output data being related to the content and including a format or protocol or language acceptable to the selected output device for output. . . .” Support for this element may be found at least in [Paragraph 0008] and [Paragraph 0068] of the present application, for example:

*The output device's input requirements correspond to the type of input that the output device (e.g., a printer) understands. For example, a printer's input requirement may include printer specific input format (e.g., one or more of an image, graphics or text format or language). Therefore, an output data (or print data in the case the output device is a printer) herein refers to data that is acceptable for input to an associated output device. Examples of input requirements may include, without limitation, audio format, video format, file format, data format, encoding, language (e.g., page description language, markup language etc), instructions, protocols or data that can be understood or used by a particular output device make and model.*

*Present application, Paragraph 0008*

*Output data (or print data in case of a printer) is the electronic data sent from an information apparatus to an output device. Output data is related to the content intended for output and may be encoded in a variety of formats and languages (e.g. postscript, PCL, XML), which may include compressed or encrypted data.*

*Some output device manufacturers may also include in the output data (or print data) a combination of proprietary or non-proprietary languages, formats, encoding, compression, encryption etc. Present application, Paragraph 0068*

The closest description associated with conforming content into an output data (or print data) in Taniguchi appear to be in column 19 lines 6-24 where Taniguchi teaches that a print server having “converting means for converting attached data to printing data in such a format which enable print by a print device.” More specifically, Taniguchi column 19 lines 11-20 recite:

*With this invention, the print server has converting means for converting attached data to print data in such a format which enables print by a print device which issued a print request. Accordingly, in the case where the attached data is written in a special image format and cannot directly be printed by some of the print devices, the data converting means of the print server converts the attached data to print data in the format that enables print by the print device that issued the print request.*

Applicant therefore asserts that Taniguchi merely teaches converting, at a print server, data to a print data in the format that enables print by the print device. However, Taniguchi does not teach or suggest “conforming at the information apparatus at least part of the digital data content into an output data”. Following the teachings of Taniguchi will lead one skilled in the art to convert data to print data at a print server and not conforming at the information apparatus content to output data.

Independent claims 31, 50, and 59 recite at least a similar element, namely conforming at an information apparatus content into an output data. Applicant therefore asserts that independent claims 29, 31, 50, and 59 are patentable as each recites at least an element not taught by Anderson or Taniguchi, either alone or in combination.

#### **10. Wireless Connection Not Including an External Print Server**

For further clarity and patentable distinction, claims 29 and 50 further recite “. . . the wireless connection not including an external print server being external to the information apparatus and the wireless output device. . . .”

Support for the element may be found for example in Figs. 2A and 2B showing a wireless communication link between the information apparatus and the output device not including for example a printer server in between the output device and the information apparatus.

### **11. Short Range Wireless Connection**

Still, for further clarity and patentable distinction, claims 29 and 50 further recite “. . . establishing a short range wireless connection. . . .”

Support for the element can be found for example in Paragraph [0081]. For example:

*In one embodiment of the present invention, communication interface 240 between information apparatus 200 and output device 220 or output system 250 is a wireless communication interface such as a short-range radio interface including those implemented according to the Bluetooth or IEEE 802.11 standard.*

### **12. Authentication**

With respect to authentication, claim 31 recites:

*. . . obtaining a security key from the user for accessing the selected wireless output device at the mobile wireless information apparatus;*

*sending at the mobile wireless information apparatus the security key over the wireless communication channel for authenticating access of the mobile wireless information apparatus to the select wireless output device;*

*receiving over the wireless communication channel at least an indication related to a successful security key authentication. . . .*

With respect to the same, the Examiner Taniguchi cites column 17 lines 30-43, a portion of which recites:

*Further, in order to inhibit the unauthorized output of image data, it is arranged that, when image data creation information is sent to the portable terminal device, a password is sent simultaneously, and when an output request is sent from the portable terminal device to the server, a password is also sent simultaneously. The password thus sent from the portable terminal device is checked by the server. If the received password is identical with the registered password, image data is sent to an output device. If not identical, it is understood that a third party other than the user is attempting to illegally access and obtain the image data. In that case, however, the image data is not sent to the output device, thereby preventing image data from being leaked to the third party.*

Applicant alleges that Taniguchi teaches a method “to inhibit unauthorized output of image data” by a print server to an output device, wherein the steps taught by Taniguchi are as follows: (1) the server send a password to the portable terminal device, (2) the portable terminal send to the server the password when an output request is sent to the server, (3) the server check if the password received from the portable device is identical to the one registered (identical to the one sent to the portable terminal), if they are identical (4) send from the server to the output device the image data.

Applicant asserts, however, that Taniguchi does not teach an information apparatus “obtaining a security key from the user for accessing the selected wireless output device at the mobile wireless information apparatus”. Instead, Taniguchi teaches the server obtaining a password from portable device in order to send image data from the server to the output device.

Applicant further asserts that Taniguchi does not teach or suggest sending at the mobile wireless information apparatus the security key over the wireless communication channel for authenticating access of the mobile wireless

information apparatus to the select wireless output device. Instead, Taniguchi teaches sending the password to the server to enable access of the server (and not the portable terminal) to the output device.

Applicant asserts further still that Taniguchi does not teach or suggest receiving over the wireless communication channel at least an indication related to a successful security key authentication. To the contrary, Taniguchi is silent and recites nothing akin to this step. Taniguchi merely teaches checking at the server if the password received from the portable terminal is identical to the registered password (the password previously sent from the server to the portable terminal). Accordingly, Taniguchi does not teach or suggest anything related to the information apparatus receiving over the wireless communication channel an indication related to a successful security key authentication.



### 13. In Dependence of a Successful Security Key Authentication

In addition to the above listed patentable distinctions, claim 31 further recites ". . . in dependence of a successful security key authentication, establishing a restricted wireless connection between the mobile wireless information apparatus and the selected wireless output device, and transferring the output data over the restricted wireless communication channel from the mobile wireless information apparatus to the selected wireless output device. . . ."

Taniguchi does not teach or suggest "in dependence of a successful security key authentication, establishing a restricted wireless connection between the mobile wireless information apparatus and the selected wireless output device." Taniguchi is silent with respect to this feature. Instead, Taniguchi describes that if the password is identical, the server sends image data from the server to the output device.

Taniguchi further does not teach or suggest "in dependence of a successful security key authentication, transferring the output data over the restricted wireless communication channel from the mobile wireless information apparatus to the selected wireless output device." Instead, Taniguchi describes that if the password is identical, the server (and not the portable terminal) sends image data from the server to the output device.

### 14. Dependent Claim 39 (Audio Device)

Dependent claim 39 recites "[t]he method according to claim 29 in which the wireless output device is an audio device."

Examiner alleges that Anderson, Figure 1, photo service site # 14, teaches an output device. Anderson column 4 line 65 bridging column 5 line 1 recites that ". . . the term image also encompasses media types such as movies, sound annotations." Anderson column 3 lines 12-21 describe photo service site # 14 as, for example"

*FIG. 1 is a block diagram illustrating a meta-application architecture for an online system 10 in accordance with a preferred embodiment of the present invention. The system 10 includes multiple client*

*devices 12 that request imaging services from multiple online photo-service sites 14. The photo-service sites 14 are sites on the Internet that provide different types of digital imaging services.*

Applicant asserts that it is well known by one ordinary skilled in the art that a "media type" is not a device. Moreover, by extension a media type cannot be an "audio device." Further, Applicant asserts that it is well known by one ordinary skilled in the art and from dictionary definition that "sites on the Internet" is not a device, regardless of which site on the Internet. Moreover, a site on the Internet is not, nor can it teach, an "audio device." Accordingly, dependent claim 39 is patentable as Anderson in view of Taniguchi, either alone or on combination, fail to teach at least that "media type" and "sites on the Internet" individually or in combination equate to a device and more specifically an audio device as recited by dependent claim 39.

#### **15. Dependent claim 45 (Discovering)**

Dependent claim 45 further recites ". . . discovering over the wireless communication channel one or more wireless output devices available for wireless connection. . . ."

Taniguchi does not teach or suggest discovering over the wireless communication channel one or more wireless output devices available for wireless connection. Instead, Taniguchi describes detecting the output device after searching information related to the output device stored in the memory of the portable terminal # 73. The portions of Taniguchi relating to "detecting" an output device are reproduced below:

*In the case where the portable terminal device 73 is used to search for the output device 74, the detection of the desired output device 74 is performed according to information on the output device 74, such as its location and performance, and the image data creation information. This output device information is stored in such a recording medium as a memory within the portable terminal device 73, a removable memory card or the like.*

*Taniguchi column 13 lines 24-27*

*The following will explain a setting procedure for a search condition with reference to FIG. 13. First of all, the user 79 uses an input device of the portable terminal device 73 to input necessary search conditions selected from output device information (S221) and stores the inputted search conditions, as reference information for the search, in the storage means (S222). Further, when searching for the output device 74, the reference information thus stored is read out, thereby detecting the output devices 74 meeting the conditions...*

*Taniguchi column 15 lines 51-59*

Applicant asserts that Taniguchi merely teaches that after searching information in a database stored in memory, the output device information is detected as a result of the search for the information stored in the memory. Accordingly, Taniguchi does not teach or suggest discovering over the wireless communication channel one or more wireless output devices available for wireless connection. Accordingly, dependent claim 45 is patentable as Anderson in view of Taniguchi, either alone or on combination, fail to teach at least discovering over the wireless communication channel one or more wireless output devices available for wireless connection.

#### **16. Dependent Claim 57 (Compression)**

Dependent claim 57 recites “[t]he medium according to claim 59 in which the software for conforming at the mobile phone information apparatus at least part of the content into an output data includes at least a compression operation.” Support for compression can be found throughout the as-filed specification, for example at least in paragraphs [0074], [0030], [0031], [0068], [0069].

### **17. Dependent Claim 42, 46, 50 (Conforming)**

Dependent claims 42, 46, and 50 further recite “. . . conforming at the information apparatus at least part of the digital data content into an output data includes using at least in part the said device dependent attribute received from the selected wireless output device over the wireless communication channel. . . .”

Neither Anderson nor Taniguchi, either alone or in combination, teach or suggests the element of “. . . using at least in part the said device dependent attribute received from the selected wireless output device over the wireless communication channel. . . .” Accordingly, Applicant asserts that dependent claims 42, 46, and 50 are patentable as each recites at least an element not taught by Anderson in view of Taniguchi.

### CONCLUSION

Based on their earliest applicable priority dates, Anderson and Taniguchi are not prior art under U.S.C. § 103 against the present application. Further, even if the Examiner can establish that Anderson and/or Taniguchi is prior art, each independent claim (e.g., independent claims 29, 31, 50, and 59) is patentable as it recites at least an element not taught or suggested by Anderson, Taniguchi, and Iwazaki either individually or in combination. Any claims depending from patentable independent claims 29, 31, 50, and 59 are also patentable at least based on their dependency from a patentable independent claim. Accordingly, Applicant asserts that claims 30, 39, 41, 42, 44-49, and 53-58 are also patentable.

The Examiner is encouraged to telephone the undersigned at (360) 750-9931 if an additional interview would be helpful in advancing the case. Applicant respectfully requests that the rejection of all pending claims be withdrawn, and that the application is in condition for allowance. Such is earnestly requested.

Respectfully submitted,

/Jon C. Reali/

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